

REMARKS

This is a full and timely response to the Office Action mailed November 16, 2005, submitted concurrently with a three month Extension of Time to extend the due date for response to May 16, 2006.

By this Amendment, claim 1 has been amended to incorporate the limitations of claim 6. Further, claims 1, 2, 7, 8, 11 and 12 have been amended to address the rejection under 35 U.S.C. §112. Claim 6 has been canceled without prejudice or disclaimer to its underlying subject matter in view of the amendment to claim 1. Finally, new claims 17-21 have been added to further protect specific embodiments of the present invention. Support for the claim amendments and new claims can be found variously throughout the specification, see for example, the original claims. Thus, claims 1-5 and 7-21 are pending in this application.

In view of this amendment and the following remarks, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above claims and the following remarks is respectfully requested.

Rejection under 35 U.S.C. §112

Claims 1-16 are rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. The Examiner has rejected the phrase "*capable of*" stating that the phrase does not recite a definite bond reaction. Although Applicant respectfully disagrees with the Examiner, in the interest of expediting the prosecution of the present application, Applicant has replaced the phrase "*capable of*" in the claims with the phrase "*which is to form*" which Applicant believes overcome this rejection. Further, Applicant believes that new claims 17-21 are definite under 35 U.S.C. §112, second paragraph since all of the Examiner's concern have been address in the new claims. Thus, withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §102

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Garipey (WO 93/23425). Applicant respectfully traverses this rejection. However, in the interest of expediting the prosecution of the present application, Applicant has incorporated the limitations of non-rejected claim 6 into claim 1, thereby rendering moot this rejection.

Rejection under 35 U.S.C. §102 and/or 35 U.S.C. §103

Claims 1-16 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly being obvious over Anderson et al. (U.S. Patent No. 5,439,829). Applicant respectfully traverses this rejection.

To constitute anticipation of the claimed invention under U.S. practice, the prior art reference must literally or inherently teach each and every limitation of the claims. Further, to establish a *prima facie* case of obviousness, the cited reference must either alone or in combination teach or suggest the invention as a whole, including all the limitations of the claims. Here, in this case, Applicant believes that Anderson et al. fails to teach or suggest all the limitations of the claims.

While Anderson et al. arguably discloses several generic and specific ligands which are useful as chelating agents, Applicant believes that Anderson et al. does not disclose a metal complex as shown in claim 9, which has a general formula of $(L_2)_mM(L_1)$, where L_1 is a ligand having a substituent $-R_2-CO-OR_2$, and where R_2 represents an arylene group. Additionally, Anderson et al. does not disclose compounds of the formulas depicted in claim 10. Still further, while Anderson et al. arguably discloses several compounds having a functional group of the formula $-NH_2$ (e.g. triethylenetetramine and biethylenetriamine) which forms a covalent bond with a biologically active molecule, none of the compounds disclosed in Anderson et al. appear to have a functional group of the formula $-NHNH_2$, as recited in claims 12 and 13.

Lastly, Anderson et al. arguably discloses that metal complexes may be used in assay systems and protein protocols, specifically indicating that the invention is useful in immobilized metal ion affinity assays (IMAC). However, Anderson et al. does not disclose or even suggest that metal complexes bound to biologically active molecules are useful in other applications, such as mass spectrometry applications. Therefore, Applicant submits that the mass spectrometry method of claim 16 is not disclosed or suggested by Anderson et al.

Thus, for these reasons, withdraw of this rejection is respectfully requested.

Applicant also submit that new claims 17-21 are allowable over Anderson et al. under 35 U.S.C. §102 and/or 35 U.S.C. §103 for the same reasons as noted above.

CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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Respectfully submitted,

By 

David T. Nikaido

Registration No.: 22,663

Lee Cheng

Registration No.: 40,949

RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W.
Suite 501
Washington, DC 20036
(202) 955-3750
Attorneys for Applicant

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